

REMARKS

Applicant wishes to thank the Examiner for the telephonic interview conducted on June 20, 2008. In light of the discussion during the telephonic interview, the following remarks are presented.

In the Office Action mailed from the United States Patent and Trademark Office on March 28, 2008, the Examiner objected to claims 54 and 55, rejected claims 44-47 and 49-52 under 35 U.S.C. 102(b) as being anticipated by Brimm et al. (United States Patent No. 5,072,383, hereinafter "Brimm"), rejected claims 21-29, 24-25, 42-43, and 44-55 under 35 U.S.C. 103(a) as being unpatentable over Evans (United States Patent No. 5,924,074, hereinafter "Evans") in view of Feldon et al. (United States Patent No. 5,732,221, hereinafter "Feldon"), Lavin et al. (United States Patent No. 5,772,585, hereinafter "Lavin"), Provost et al. (United States Patent No. 6,341,265, hereinafter "Provost") and Lancelot et al (United States Patent No. 6,434,531, hereinafter "Lancelot"), and rejected claims 44-55 under 35 U.S.C. 103(a) over Brimm in view of Provost. Accordingly, Applicant respectfully provides the following:

Objection to Claims 54 and 55

In the Office Action, the Examiner objected to claims 54-55. Applicant respectfully submits that the amendments provided herein overcome the objections made by the Examiner to Claims 54 and 55.

Rejections under 35 U.S.C. §102

In the Office Action, the Examiner rejected claims 44-47 under 35 U.S.C. 102(b) as being anticipated by Brimm. Applicant respectfully submits that the amended claim set as provided herein is not anticipated by the cited references. The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

“... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Applicant respectfully submits that Brimm does not teach every aspect of the amended claim set as provided herein and therefore does not anticipate the claims of the present invention. In particular, independent claim 44 recites a method for creating a form for use by a specialized healthcare provider, comprising: selecting the specialized healthcare provider; determining a first pool of healthcare procedures characteristically rendered by the specialized healthcare provider; determining a second pool of healthcare diagnoses characteristically employed by the specialized healthcare provider; generating the form wherein the form comprises the first pool and the second pool of healthcare procedures and diagnoses characteristically performed and employed by the specialized healthcare provider; and assigning insurance codes to the first pool and the second pool of healthcare procedures and diagnoses, the specialized healthcare provider employing the form to record healthcare service information of a patient, wherein the insurance codes are automatically recorded on an insurance invoice, in real time, during employment of the form by the specialized healthcare provider as part of the healthcare services provided to the patient, the insurance codes representing the recorded healthcare service information of the patient wherein the process of employing the form to record healthcare service information of the patient automatically records the insurance codes on the insurance invoice.

Such recitation of independent claim 44 is supported by the disclosure as originally filed. For example, reference is made to broader applications of the invention that are “directed towards...those situations wherein...reporting, and billing records are coordinated during...patient...meetings (page 26, lines 9-13). Additionally, Figures 8, 10B, 12, 15 and 16 illustrate various images and flow diagrams showing the process of selecting diagnoses and

procedures, and having representative billing codes automatically entered on the appropriate insurance invoices. In contrast, Brimm does not teach nor suggest, either explicitly or impliedly, every aspect of the amended claim. Accordingly, Applicant respectfully submits that independent claim 44 is not anticipated by Brimm. Furthermore, since dependent claim 44 is not anticipated by Brimm, any corresponding dependent claims are also not anticipated by Brimm. Thus, Applicant respectfully submits that the claim set as provided herein is not anticipated by the cited reference.

Rejections under 35 U.S.C. §103

The Examiner rejected claims 21-29, 24-25, 42-43, and 44-55 under 35 U.S.C. 103(a) as being unpatentable over Evans in view of Feldon, Lavin, Provost, and Lancelot, and rejected claims 44-55 under 35 U.S.C. 103(a) over Brimm in view of Provost. Applicant respectfully submits that the amended claim set as provided herein is not made obvious by the cited references.

The Supreme Court in *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) held that the factors a court will look at when determining obviousness and non-obviousness in the United States, are those factors outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966), commonly referred to as the "Graham factors". The court held that obviousness should be determined by looking at the four "Graham factors" including: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) objective evidence of nonobviousness. In addition, the Court outlined examples of factors that show "objective evidence of nonobviousness." These factors include: 1) commercial success; 2) long-felt but unsolved needs; and 3) failure of others.

“The legal concept of *prima facie* obviousness is a procedural tool [that] ... allocates who has the burden of going forward with production of evidence in each step of the examination process.” MPEP §2142. “To reach a proper determination [of obviousness] under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.” *Id.* “If the examiner determines there is a factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence.” *Id.*

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest all of the limitations claimed in the present invention. In particular, independent claim 21 recites a method for generating, displaying and recording healthcare service information in a system that is configured to be associated with healthcare services, the method comprising: electronically selecting a pool of healthcare procedures characteristically performed by an individual healthcare provider of a healthcare facility for inclusion in a customized form, wherein the pool of healthcare procedures reflect the medical services rendered by the individual healthcare provider; electronically selecting one or more healthcare diagnoses characteristically employed by the individual healthcare provider for inclusion in the customized form, wherein the one or more diagnoses are reasons for performing at least one of the procedures from the pool of

healthcare procedures characteristically performed by the individual healthcare provider; generating the customized form in a generally integrated graphical display, by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the individual healthcare provider and the healthcare diagnoses characteristically employed by the individual healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the customized form comprises, using a computer interface to define a new structure for the customized form that is not generated from a printed data form, selecting a number of rows for inclusion into the customized form, defining specifications relating to the pool of healthcare procedures as performed by the individual healthcare provider in the practice of the individual healthcare provider, defining specifications relating to the one or more healthcare diagnoses pertaining to the practice of the individual healthcare provider, displaying a reference to the customized form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes curtailed to the practice of the individual healthcare provider, and displaying a preview of the customized form; and determining a particular sequence of the pool of healthcare procedures based upon user preferences; selecting at least one of (i) a diagnosis of the customized form and (ii) a procedure of the customized form in association with the individual healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient; displaying billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient; and automatically recording an insurance code entry on an insurance invoice, the insurance code

entry representing the diagnosis and the procedure selected by the specialized healthcare provider, wherein the process of selecting the diagnosis and the procedure automatically creates the insurance code entry on the insurance invoice.

Additionally, independent claim 42 recites a method for generating, displaying, recording and automatically billing healthcare service information, the method comprising: electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider; electronically selecting a healthcare diagnosis characteristically employed by the particular healthcare provider for inclusion in the customizable form, wherein the healthcare diagnosis is a reason for performing a procedure from the pool of healthcare procedures characteristically performed by the particular healthcare provider; generating the customizable form by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the particular healthcare provider and the healthcare diagnoses characteristically employed by the particular healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the customizable form comprises, using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures, defining specifications relating to the healthcare diagnosis, displaying a reference to the customizable form in a searchable field within a form definition window, populating one or more fields of the form definition window, displaying the form definition window with the populated fields, entering procedure and diagnosis codes, and displaying a preview of the customizable form;

determining a particular sequence of the pool of healthcare procedures based upon user preferences; selecting at least one of (i) a diagnosis of the customizable form and (ii) a procedure of the customizable form in association with the healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient; and automatically recording an insurance code entry on an insurance invoice, the insurance code entry representing the diagnosis and the procedure selected by the specialized healthcare provider, wherein the process of selecting the diagnosis and the procedure automatically creates the insurance code entry on the insurance invoice. Furthermore, independent claim 44 (as recited above) teaches limitations not included in the cited references.

In particular, the amended independent claims 21, 42, and 44 provide methods relating to generating, displaying, recording and automatically billing healthcare service information and include an additional limitation wherein a process of selecting a diagnosis and a procedure automatically creates an insurance code entry on an insurance invoice. This additional limitation is not taught nor suggested by the cited references and therefore the amended independent claims 21, 42, and 44 are not anticipated by the same. This additional limitation is supported by the originally filed disclosure, as discussed above. In contrast, none of the references cited by the Examiner, alone or in combination teaches or suggests such limitations.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination do not teach or suggest all the claim limitations. Furthermore, since the cited references do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious independent claims 21, 42, and 44 as provided herein. Finally, since the prior art references do not make obvious independent claims 21, 42, and 44, Applicant

respectfully submits that the prior art references cited by the Examiner do not make obvious the corresponding dependent claims, which depend from independent claims 21, 42, and 44.

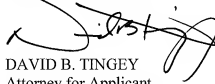
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 30th day of June, 2008.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. B. Tingey', with a large, stylized flourish at the end.

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